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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,809

03/08/2004

Steven T. Kirsch

ABC-013

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7590

09/03/2008

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EXAMINER

HOANG, HIEU T

ART UNIT

PAPER NUMBER

2152

MAIL DATE

DELIVERY MODE

09/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,809	Applicant(s) KIRSCH, STEVEN T.	
	Examiner HIEU T. HOANG	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the communication filed on 07/17/2008.
2. Claims 1-26 are pending.

Response to Amendment

3. Previous objections and 35 U.S.C. 112 rejections have been withdrawn due to the amendment.

Response to Arguments

4. Applicant's arguments on the 35 U.S.C. 102 rejections have been fully considered but they are not persuasive. The applicant argues that the prior art of record does not teach identifying an actual sender of the received e-mail message by at least using an e-mail address of an actual sender. The examiner respectfully disagrees. Refer to fig. 2 of Liu, in step 202, a sender's email address is identified from the received email and is used to categorize and process the email accordingly (steps 207-211). The claims recite using *at least one* technique to identify origin-identifying information. Therefore, applicant's arguments regarding other techniques are unpersuasive. Argument regarding differences between an actual sender and an apparent sender is vague since the differences are not recited in the claims. Applicant further argues that Liu does not teach categorizing the received email as either solicited or unsolicited. The examiner respectfully disagrees. Liu teaches checking whether the

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received email is blacklisted (unsolicited) or whitelisted (solicited) using the sender's email address (fig. 2).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to make or use the invention, i.e., failing to disclose “apparent sender” as recited in claims 2, 11 and 20.

7. Applicant’s disclosure is insufficient to allow one of ordinary skilled in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary steps to perform the method (such as in claim 170). See *In re Gunn*, 190 USPQ 402 (CCPA 1976.) In fact, applicant’s disclosure does not even include “apparent sender”.

8. Claims 2, 11 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner cannot find any disclosure in the specification regarding “apparent sender”.

9. It is suggested that applicant could overcome the U.S.C. 112 first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-

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indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 2, 9, 10, 19, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite “an apparent sender.” There is no support for what is meant by “apparent” in the specification. Therefore, “an apparent sender” is read as a sender.

12. Claims 1 and 2 in group of independent claim 1 are inconsistent for claiming “an actual sender” and “an apparent sender.” These two are believed to be the same, since no distinction between the two can be deduced from the claims or the specification. Therefore, reciting them separately makes the claims vague and indefinite. Same rationale applies to other claim groups.

13. Furthermore, according to MPEP 2173.05(u), “the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would constitute an improper use of the trademark or trade name.” Claims 2, 20 and 20 recite “Sendmail®” and “MAIL FROM.” This is either a vague product name that represent trademarked subject matter.

14. Correction is required.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Liu et al. (US 2005/0015455, hereafter Liu).

17. For claim 1, Liu discloses in a network, a method of processing received e-mail messages comprising:

a) identifying origin-identifying information about an origin of a received e-mail message (fig. 2, steps 200-202, receive an email and extract its sender's address), the origin-identifying information based on data from at least one item of data in the received e-mail message or at least one item of data used to send the received e-mail message, the origin-identifying information including at least one of the following:

- i) an actual sender of the received e-mail message (fig. 2, step 202, identifying sender's email address from the received email message);
- ii) a final Internet Protocol address;
- iii) a final domain name;

- iv) a normalized reverse Domain Name Service lookup of the final Internet Protocol address; or
- v) an Internet Protocol path used to send the received e-mail message;
- b) categorizing whether the received e-mail message is solicited or unsolicited by using statistics based on the information about the origin of the received e-mail message (fig. 2, step 207, check whether the sender is in the black list or white list based on pre-established statistics...); and
- c) processing the received e-mail message based on its categorization (fig. 2, case a, b, or c follows categorization).

18. For claim 2, Liu further discloses the actual sender is identified by combining at least two of the following: a) an e-mail address used by an apparent sender (fig. 2, sender's email address); b) a display name used by the apparent sender; c) the final Internet Protocol address; d) the final domain name ([0043], domain name); e) the normalized reverse Domain Name Service lookup of the final Internet Protocol address; f) a MAIL FROM address of the received e-mail message; g) a domain name used by the apparent sender; h) a name of client software used by the apparent sender; i) user-agent; j) timezone; k) source Internet Protocol address; l) version of Sendmail used by an initial receiver; m) the Internet Protocol path used to route the received e-mail message; n) a range of Internet Protocol addresses; o) owner data stored in databases; (fig. 1, data center, database storing user information such as black list and white list) or p) a normalized MAIL FROM address of the received e-mail message.

19. For claim 3, Liu further discloses using statistics compiled at at least one database to categorize whether the received e-mail message is solicited or unsolicited (fig. 2, black list, white list).

20. For claim 4, Liu further discloses computing a score indicating a likelihood that the received e-mail message is unsolicited using the statistics compiled at the at least one database ([0020], number of e-mail messages from the same sender is a score or is used to calculate a score of spam likelihood).

21. For claim 5, Liu further discloses sending information about received e-mail messages to the at least one database (fig. 1, data center 102), the sent information including at least two of the following: a) information identifying the actual sender (fig. 2, sender's address, black list, white list); b) whether the actual sender is included on a recipient's whitelist (fig. 2, black list, white list); c) whether the actual sender is included on a recipient's blacklist (fig. 2, black list, white list); d) information identifying the final Internet Protocol address; e) whether the final Internet Protocol address is included on the recipient's whitelist; f) whether the final Internet Protocol address is included on the recipient's blacklist; g) information identifying the final domain name; h) whether the final domain name is included on the recipient's whitelist; i) whether the final domain name is included on the recipient's blacklist; j) information identifying the normalized reverse Domain Name Service lookup of the final Internet Protocol address; k) whether the

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normalized reverse Domain Name Service lookup of the final Internet Protocol address is included on the recipient's whitelist; l) whether the normalized reverse Domain Name Service lookup of the final Internet Protocol address is included on the recipient's blacklist; m) information identifying the Internet Protocol path; n) whether the Internet Protocol path is included on the recipient's whitelist; o) whether the Internet Protocol path is included on the recipient's blacklist; p) whether the received e-mail message could be categorized locally; or q) whether a recipient changed a recipient's whitelist/recipient's blacklist status of the received e-mail message.

22. For claim 6, Liu further discloses requesting the at least one database to send statistics to a recipient about the origin-identifying information (fig. 2, query the database to get whether the sender is on black or white list).

23. For claim 7, Liu further discloses storing origin-identifying information from received e-mail messages including at least one of the following: a) a total number of e-mail messages sent ([0020]); b) a number of e-mail messages sent over a first predetermined time period; c) a total number of e-mail messages sent to recipients in a network who have included the origin on a recipient's whitelist; d) a number of e-mail messages sent to recipient in the network who have included the origin on the recipient's whitelist over a second predetermined time period; e) a number of recipients who have included the origin on the recipient's whitelist; f) a total number of times a recipient changed the origin's recipient's whitelist/recipient's blacklist status; g) a

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number of times a recipient changed the origin's recipient's whitelist/recipient's blacklist status over a third predetermined time period; h) a total number of e-mail messages sent to recipients in the network who have not included the origin on the recipient's whitelist; i) a number of e-mail messages sent to recipients in the network who have not included the origin on the recipient's whitelist over a fourth predetermined time period; j) a total number of unique recipients in the network who have received at least one message from the origin; k) a total number of e-mail messages sent to unique recipients in the network who have included the origin on the recipient's whitelist; or l) a total number of e-mail messages sent to unique recipients in the network who have not included the origin on the recipient's whitelist.

24. For claim 8, Liu further discloses compiling statistics includes at least one of the following: a) determining a ratio of a first number of e-mail messages sent from the origin to recipients in the network who have included the origin on a recipient's whitelist in a predetermined time period divided by a second number of e-mail messages sent from the origin to recipients in the network in the predetermined time period; b) determining a ratio of a first number of recipients in the network who have included the origin on the recipient's whitelist divided by a second number of unique recipients in the network who received e-mail messages from the origin in the predetermined time period; c) determining a ratio of a first number of times in a predetermined time interval the origin of an e-mail message was moved from the recipient's whitelist to a recipient's blacklist divided by a second number of times the origin of the e-mail message was

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moved from the recipient's blacklist to the recipient's whitelist; d) determining a ratio of a first number of times in a predetermined time interval the origin of an e-mail message was moved from the recipient's blacklist to the recipient's whitelist divided by a second number of times the origin of the e-mail message was moved from the recipient's blacklist to the recipient's whitelist; e) determining a ratio of a first number of unique users within the network who recipient's whitelisted the origin within a predetermined time period compared to a second number of unique users within the network who recipient's blacklisted the origin within the predetermined time period; f) determining a ratio reflecting whether the origin sends a majority of e-mail messages to recipients who have included the origin on the recipient's whitelist; g) determining a ratio reflecting a first number of wanted e-mail messages sent by the origin compared to a second number of unwanted or total e-mail messages sent by the origin; h) determining a difference between a first number of expected e-mail messages sent by the origin and a second number of unexpected e-mail messages sent by the origin; i) determining a difference between a first number of times a user whitelisted the origin of an e-mail message and a second number of times a user recipient's blacklisted the origin of the e-mail message; j) determining a difference reflecting whether the origin sends a majority of e-mail messages to known recipients; k) converting any of the above ratios or differences to a score indicating a likelihood the received e-mail message is unsolicited; or l) applying the score to appropriate messages in a spam folder ([0020], identify all emails from a sender are spam if the score is higher than a threshold).

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25. For claim 9, Liu further discloses setting a predetermined threshold for accepting received e-mail messages based on statistics associated with the origin-identifying information ([0020], predetermined threshold of spam likelihood).

26. For claim 19. In a network, a method for categorizing received e-mail messages comprising:

a) collecting information about an origin of an e-mail message, the origin-identifying information including at least one of the following: i) an actual sender; ii) a final Internet Protocol address; iii) a final domain name; iv) a normalized reverse Domain Name Service lookup of the final Internet Protocol address; or v) an Internet Protocol path used to send the message (fig. 2, step 200-202, receive an email and check its sender's address); and

b) compiling statistics at at least one database about the origin based on the origin-identifying information, wherein the statistics are used to categorize whether the received message is solicited or unsolicited ([0020], score indicating that the sender is spammer if the score is higher than a predetermined threshold).

27. Claims 10-18 are rejected for the same rationale given in claims 1-9 respectively.

28. Claim 20 is rejected for the same rationale given in claim 2.

29. Claims 21-26 are rejected for the same rationale given in claims 4-9 respectively.

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is included in form PTO 392.

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hieu T. Hoang whose telephone number is 571-270-1253. The examiner can normally be reached on Monday-Thursday, 8 a.m.-5 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HH

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2152